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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Richard Gaohua Wang

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EXAMINER

CHANG, JUNGWON

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/710,746		WANG ET AL.	
	Examiner		Art Unit	
	Jungwon Chang		2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-22 are presented for examination.
2. Claims 2, 4, 7, 10, 11, 20, 21 are objected to because of the following informalities:

Line 1, "said the instant message" should be "said instant message".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - i. The statute does not prescribe a set **claim** form; nor is a set **claim** form required by 37 CFR § 1.75. The **single sentence claim requirement** of MPEP §608.01(m) is a matter of form under PTO practice.
 - ii. Claim 6 recites the limitation "the mobile device" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 5-7 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Bernstein et al. (US 2004/0128356), hereinafter Bernstein.

7. As to claim 1, Bernstein discloses the invention as claimed, including a method for processing of an instant message by utilizing HTTP URL technology (page 6, 0115, 0118-0123), comprising:

each instant message user has a globally unique HTTP URL as its identification, refer to as URL for instant message (page 3, 0050, "instant messaging session has a universally unique identifier"; page 4, 0064; page 5, 0100; page 6, 0115, 0118-0123). When the sender wants to communicate with the receiver, just enters the receiver's URL for instant message in any internet browser like surfing a website (page 7, 0132, "instant messaging URL"; page 8, 0153). If the receiver is online, they will then be able to communicate with each other (page 7, 0132, "instant messaging URL"; page 8, 0153, "instant messaging invitation"). There is no need to download and install any client software on the sender and receiver's computer (page 2, 0022-0024, "users may

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message each other without the need for explicit client software download"). Either party does not necessarily need to know which instant message client software the other party is using (page 2, 0022-0024).

8. As to claim 2, Bernstein discloses wherein said instant message user's identification is not a number or email account obtained from instant message service provider in a closed system. It is a HTTP URL that can be visited by using any Internet access device with Internet browser (page 7, 0132, "instant messaging URL"; page 8, 0153).

9. As to claim 3, Bernstein discloses wherein said there are no need to download and install any instant message client software on sender's and receiver's computer in order to use instant message service (page 2, 0022-0024, "users may message each other without the need for explicit client software download").

10. As to claim 5, Bernstein discloses wherein said when the sender of instant message wants to initialize a conversation with some one else that has URL for instant message, the sender just enter the receiver's URL for instant message in any internet browser no matter if the sender has URL for instant message. If the receiver is online, they will then be able to communicate with each other using secured connection (page 2, 0016, "initiating instant messaging"; page 3, 0030-0031, "supporting instant messaging between at least two users").

11. As to claim 6, Bernstein discloses wherein said if the receiver's status is offline, when a conversation request is made by another party, the system is also capable of detecting if the receiver is using any other instant message services and forward the request to the receiving party. Alternatively, the receiving party can be notified by email or by SMS to the device (page 3, 0055-0056, "alerts regarding instant messaging invitations"; page 8, 0148).

12. As to claim 7, Bernstein discloses wherein said user that can have its own domain name and assign a URL for instant message service using its own domain name, only need to change its domain name's DNS server to the URL for instant message service provider's DNS server (email address inherently includes its own domain name).

13. As to claim 9, Bernstein discloses using URL for instant message to provide live help service for enterprise user. The enterprise user can use the URL as a public communication tool and provide live help service for its customers and its website visitors. Any one visits its website can instantly get response from the website live help operator or customer support person by simply clicking the URL for instant message hyperlink that embedded in the website (100, fig. 1; page 2, 0015; page 3, 0049; page 7, 0132, "instant messaging URL"; page 8, 0153).

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14. As to claim 10, Bernstein discloses wherein said instant message enterprise use can provide a live help service by embedded the URL for instant message in their website. When visiting the website, help can be easily accessed by clicking on the live help hyper link to URL for instant message (100, fig. 1; page 2, 0015; page 3, 0049; page 7, 0132, "instant messaging URL"; page 8, 0153).

15. As to claim 11, Bernstein discloses wherein said instant message enterprise user can apply a web page monitor URL and embed the monitor URL to any web page that want to be monitored, then the live help operator can monitor which page is surfing by the website visitor and can invite the visitor for chat to provide live person help (100, fig. 1; page 2, 0015; page 3, 0049; page 7, 0132, "instant messaging URL"; page 8, 0153).

16. As to claim 12, Bernstein discloses wherein said if the live help operator is offline, then the live help button will be changed to offline status. The visitor can leave message to the operator's URL for instant message account or forward to its email account (100, fig. 1; page 2, 0015; page 3, 0049; page 7, 0132, "instant messaging URL"; page 8, 0153).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 4 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein et al. (US 2004/0128356), hereinafter Bernstein, in view of Mendiola et al. (US 2002/0007398), hereinafter Mendiola.

19. As to claim 4, although user logging onto the instant message server to verify the user's identity is well known in the art, Bernstein does not specifically disclose logging into instant message account. Mendiola discloses logging into instant message account. (page 6, 0091). It would have been obvious to one of ordinary skill in the art of the invention was made to combine the teachings of Bernstein and Mendiola because Mendiola's logging into account would allow the server to trace user's activity and verify his identity (Mendiola, page 6, 0091).

20. As to claim 19, Bernstein disclose invention substantially claimed, including a method for email application using URL for instant message (page 5, 0100, "URL containing in the email initiating the whole instant messaging session"), comprising:

the user that has URL for instant message can use this URL as an alternative to traditional email (page 1, 0001, "instant messaging paradigm with or without email integration" page 5, 0100, "URL containing in the email initiating the whole instant messaging session"; page 6, 0115, 0119, 0121-0122). Anyone can send message to the user no matter if he/she is online by entering the URL for instant message in any

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Internet browser (page 3, 0049, 0051, "web browser") (page 2, 0023 ; page 5, 0100; page 6, 0115, 0119, 0121-0122).

21. Bernstein discloses user managing the instant messages, and sending email to traditional email (page 1, 0001, 0013, "instant messaging paradigm with email integration"). Although user logging onto the instant message server to verify the user's identity is well known in the art, Bernstein does not specifically disclose logging into instant message account. Mendiola discloses managing the messages by login to his/her URL for instant message account as well as sending email to traditional email account (page 6, 0091). It would have been obvious to one of ordinary skill in the art of the invention was made to combine the teachings of Bernstein and Mendiola because Mendiola's logging into account would allow the server to recognize the user and verify his identity (Mendiola, page 6, 0091).

22. As to claim 20, Bernstein discloses wherein said user can be use the URL for instant message as URL for email, no need to have a traditional email account, if someone want to send message to the user, just need to enter the user's URL for email in the internet browser and leave message online and attach a file, then send to the user's account (page 6, 0122, 0123).

23. As to claim 21, Bernstein discloses wherein said user can check and message his/her messages by entering his/her URL for email in the internet browser, or using a

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URL for email client software to check and manage its URL for email account for easily manage its email in local computer (page 6, 0115, 0118-0123).

24. As to claim 22, Bernstein discloses wherein said user can use URL for email system to send/receive email to/from traditional email account on the web-based interface or URL for email client software (page 6, 0115, 0118-0123).

25. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein, in view of Luo et al. (US 2005/0256925).

26. As to claim 8, Bernstein discloses wherein said user could use this instant message service to communicate online by using text message, voice chat. The service can also be extended to collaborate with colleagues (page 3, 0057, "voice"; page 7, 0126, "text message"). However, Bernstein does not specifically disclose video conference and online game. Luo discloses video conference and online game (page 1, 0005; page 2, 0021). It would have been obvious to one of ordinary skill in the art of the invention was made to combine the teachings of Bernstein and Luo because Luo's video conference and online game would increase the capability of Bernstein's instant messaging system to include the video conference and online game (Luo, page 1, 0005; page 2, 0021).

27. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable

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over Mendiola et al. (US 2002/0007398), hereinafter Mendiola, in view of Bernstein et al. (US 2004/0128356).

28. As to claim 13, Mendiola discloses the invention substantially as claimed, including a method for mobile instant message application using URL for instant message (page 5, 0073; page 6, 0094-0095), comprising:

Every mobile user has a globally unique URL for mobile instant message service (page 5, 0073; page 6, 0094-0098). User can use mobile phone that have Internet access and Internet browser to user instant message service (page 1, 0011 ; page 2, 0040 ; page 4, 0064). Mobile phone user can use instant message service to communicate with other mobile users or computer instant message user (page 1, 0008, "client user is able to set up a network of friends or colleagues").

29. Mendiola does not specifically disclose that no instant message client software is required to be embedded in mobile phone. However, Bernstein discloses no instant message client software is required to be embedded in a user (page 2, 0022-0023). It would have been obvious to one of ordinary skill in the art of the invention was made to combine the teachings of Mendiola and Bernstein because Bernstein's no requiring instant message client software would allow any user with a popular browser to immediately, and seamlessly, participant in the instant message system (Bernstein, page 2, 0022).

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30. As to claim 14, it is rejected for the same reasons set forth in claim 13 above. In addition, Mendiola discloses wherein said every mobile user has a unique URL as identification for mobile instant message corresponding to its mobile phone number. If the mobile phone can use Internet browser to access Internet, then the mobile phone can be used as mobile instant message device (page 6, 0095, 0098).

31. As to claim 15, it is rejected for the same reasons set forth in claim 13 above. In addition, Mendiola discloses wherein said mobile phone user can use instant message communicate with PC-based instant message user or other mobile device user that have URL for instant message (page 6, 0095, 0098, "PC-based").

32. As to claim 16, Mendiola discloses wherein said if the mobile phone does not support internet access, then the mobile phone user can still send/receive SMS to/from a URL for instant message user no matter if the URL for instant message user is using mobile device or computer (page 1, 0012).

33. As to claim 17, Mendiola discloses wherein said if the mobile phone is powered off, all SMS that send to this mobile phone can forward to the user's computer if the user login the URL for mobile instant message in computer (page 1, 0012; page 6, 0091, "upon logging on, the user is notified of any messages that have been received by the IM server").

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34. As to claim 18, Mendiola discloses wherein said if the mobile phone is powered off, all SMS that send to this mobile phone can forward to the user's computer if the user login the URL for mobile instant message in computer (page 1, 0012; page 6, 0091, "upon logging on, the user is notified of any messages that have been received by the IM server").

Conclusion

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Szeto et al, US 2005/0234885, Malik et al, US 2005/0044144, Kessen et al, US 2006/0026253 disclose a method and system for integration of instant messaging with internet.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jungwon Chang whose telephone number is 571-272-3960. The examiner can normally be reached on 9:30-6:00 (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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Jungwon Chang
Primary Examiner
July 26, 2006